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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------|-------------|----------------------|---------------------|------------------|
| 09/774,686 | 02/01/2001 | Shigeki Watanabe | 837.1960/JDH | 3081 |
| 21171 | 7590 | 07/11/2005 | EXAMINER | |
| STAAS & HALSEY LLP | | | PHAN, HANH | |
| SUITE 700 | | | | |
| 1201 NEW YORK AVENUE, N.W. | | | ART UNIT | PAPER NUMBER |
| WASHINGTON, DC 20005 | | | 2638 | |

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/774,686 | WATANABE, SHIGEKI |
| | Examiner | Art Unit |
| | Hanh Phan | 2638 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 February 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,5,6,12,14,15,18,19,24 and 26-30 is/are rejected.
- 7) Claim(s) 3,4,7-11,13,16,17,20-23,25,31 and 32 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the appeal brief filed on 04/26/2005, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 2, 5, 6, 12, 14, 15, 18, 19, 24 and 26-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 09/814,762 (Watanabe et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations recited in claims 1, 2, 5, 6, 12, 14, 15, 18, 19, 24 and 26-30 of the instant application are encompassed by claims 1-28 of copending Application No. 09/814,762 (Watanabe et al).

Regarding claims 1, 14 and 26, Watanabe et al (copending Application No. 09/814,762) discloses a method comprising the steps of:

inputting an optical signal into an optical waveguide structure for providing a nonlinear effect;

generating chirp in the optical signal by the nonlinear effect ; and

supplying an output optical signal output from the optical waveguide structure to an optical filter having transmission bands at longer and shorter wavelength sides than a center wavelength of the output optical signal from the optical waveguide structure to remove a component in which the chirp is small from the output optical signal , the transmission bands at longer and shorter wavelength sides being longer and shorter for a predetermined wavelength distant from the center wavelength (see claim 1 of Watanabe et al).

Regarding claims 2 and 15, Watanabe et al (copending Application No. 09/814,762) discloses the optical waveguide structure comprises an optical fiber for providing normal dispersion (see claim 2 of Watanabe et al).

Regarding claims 5 and 18, Watanabe et al (copending Application No. 09/814,762) discloses further comprising the step of supplying the optical signal to be input into the optical waveguide structure to an optical filter to remove a noise component outside of a signal band in the optical signal (see claim 1 of Watanabe et al).

Regarding claims 6, 19 and 30, Watanabe et al (copending Application No. 09/814,762) discloses further comprising the step of optically amplifying the optical signal to be input into the optical waveguide structure so that a required amount of chirp is obtained (see claim 4 of Watanabe et al).

Regarding claims 12, 24 and 29, Watanabe et al (copending Application No. 09/814,762) discloses wherein the optical signal to be input into the optical waveguide structure comprises WDM signal light obtained by wavelength division multiplexing a plurality of optical signals (see claims 6 and 24 of Watanabe et al).

Regarding claim 27, Watanabe et al (copending Application No. 09/814,762) discloses a second optical fiber transmission line for transmitting the output optical signal (see claim 13 of Watanabe et al).

Regarding claim 28, Watanabe et al (copending Application No. 09/814,762) discloses an optical transmitter connected to an input end of the optical fiber transmission line, and an optical receiver connected to an output end of the second optical fiber transmission line (see claim 13 of Watanabe et al).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

4. Claims 3, 4, 7-11, 13, 16, 17, 20-23, 25, 31 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Claims 1-32 are allowed (if overcome the double patenting rejection).

Response to Arguments

6. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh Phan whose telephone number is (571)272-3035.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth Vanderpuye, can be reached on (571)272-3078. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-4700.



HANH PHAN
PRIMARY EXAMINER